

to make and/or use the invention. The objection is respectfully traversed, on the ground that the specification teaches a person skilled in the art to make and use the claimed invention without undue experimentation.

The Examiner apparently asserts that the specification does not support the encoder unit (16), control (14) and microprocessor (142).

Applicant has addressed and met the Examiner's concerns regarding the adequacy of the description of these elements, by previous submission of evidence, including two declarations of the inventor, Ze'ev Drori, and the declaration of Carl Angotti. This evidence has rebutted the questions raised by the Examiner.

Regarding the encoder 14, encoders of the type used in applicant's described embodiment were well known in the art at the time of his invention. The Angotti declaration establishes this fact at paragraph 14, for example, and identifies one exemplary commercially available IC (the Supertex ED9 device). Moreover, remote control vehicle security systems were known which included transmitters with encoders. A third declaration of Ze'ev Drori, is submitted herewith. Paragraph 5 of the Drori establishes the well known nature of encoders and remote control transmitters.

For these reasons, applicant abundantly met the requirements of Section 112. An applicant is simply not required to set out in his application that which is well known to those skilled in the art at the time of his invention. And while the Examiner may challenge the adequacy of the description, when the applicant has made an evidentiary showing that the description was adequate for one skilled in the art to practice the invention, there remains no basis for the rejection.

L

Applicant respectfully urges the Office to recognize this evidence, and reconsider and withdraw the Section 112 rejection.

The Examiner has further asserted that "the description of the elements and programs in issue in the original disclosure and their interaction in the system can, in general, only be described as conceptual." Applicant respectfully disagrees. The specification is lengthy and replete with details of the functions and circuits involved in an exemplary embodiment of the invention. The drawings with the original specification correspond in the level of detail to schematics of an actual device put into commercial production which embodies the invention. As requested by the Examiner, the declaration of Mr. Drori submitted herewith provides a correlation of drawings in the specification with schematics attached to Mr. Amirpoor's declaration filed June 1, 1995.

The Examiner has cited two new authorities, *In re Smyth*, 90 USPQ 106, and *Ex parte Butler*, 217 USPQ 290. *In re Smyth* concerned the prior patent statutes, which were superseded by Title 35, USC. That decision concerned the adequacy of the description in a 1939 British provisional specification to support claims drawn to a television receiver and a method for reproducing television images. That provision specification did not include any drawings, and was less than one printed column in length. The CCPA indicated that because the specification did not include any drawing as required by Revised Statute Sec. 4889, Rule 49, did not disclose means for controlling an operating characteristic of the television receiver, did not disclose control means responsive to control signals, and did not disclose an adjusting means set out in the claims, the rejection would be upheld. As for the CCPA's reasoning to state that the Board of Appeals did not error in refusing to consider affidavits, that apparently was based on an

earlier decision, *In re Oppenauer*, 62 USPQ 297. ("It is well-settled law that testimony will not be received for the purpose of explaining the disclosure of a pending application except in very exceptional cases.") However, these grounds clearly do not represent the state of the law or the patent office procedure, regarding declarations submitted to factually demonstrate that applicant's specification is in fact sufficient to meet the enablement requirements of Section 112. See, e.g. MPEP § 2106.02, at pages 2100-5 and 2100-7. As the MPEP notes, it is common practice for applicants to meet a rejection based on the enablement provisions of Section 112, first paragraph, with declarations to provide evidence to meet this challenge and factually demonstrate the adequacy of the disclosure.

Ex parte Butler, 217 USPQ 290, involved a rejection under Section 112, first paragraph, wherein the specification in question did not include any description of structure to perform the functions required by the claims. Apparently the specification included a flow chart but no other drawings of the claimed apparatus for moving the pen and chart of a recorder. The Board reversed the rejection, holding that Section 112 contains no requirement for a structural disclosure and that the examiner had not presented a *prima facie* case that the specification was not enabling. In this case, the Board noted the affidavit presented by a third party attesting to the sufficiency of the disclosure, although holding their conclusion did not depend on the affidavit. This case clearly demonstrates that evidence in the form of written declarations should be considered in determining a rejection based on the enablement provision.

The objection to the specification under 35 USC § 112, second paragraph, should therefore be withdrawn.

Claims 95-103 stand rejected under 35 USC § 112, first paragraph, for the reasons set forth in the objection to

the specification. The rejection should be withdrawn for the same reasons discussed above.

The Rejection of Claims 95-106 under 35 USC § 103.

The claims stand rejected under 35 USC § 103 as being unpatentable over Pinnow in view of Aydin, Tolson and Sanders et al. The rejection is respectfully traversed. Applicant does not agree with the Examiner's characterization of the teachings of the cited references.

Claims 95-106 are drawn to an electronically programmable remote control vehicle security system, comprising a precoded remote control transmitter for generating and transmitting a non-user-programmable, digitally encoded radio frequency signal representative of a multiple-bit transmitter code, the transmitter code being precoded so that a system user is not required to encode the transmitter or know the transmitter code. The claims further include a radio frequency receiver responsive to the radio frequency transmitter signal to provide receiver signals indicative of the transmitter code, and a system control unit disposed within the vehicle and having control over the vehicle antitheft apparatus, the control unit comprising: a digital memory; programming apparatus responsive to the receiver signals for recording in the memory only during a programming mode the transmitter code as a signature control signal for arming or disarming the vehicle antitheft apparatus, operating apparatus operable during a system security operating mode and responsive to the receiver signals for comparing the receiver signals to the recorded signature control signal and arming the vehicle antitheft apparatus upon a first receipt and recognition of receiver signals corresponding to the signature control signal, and for disarming the antitheft apparatus upon a

second receipt and recognition of receiver signals corresponding to the signature control signal.

None of the references of record describe this invention, including the combination of a transmitter which transmits a non-user-programmable signal (Claim 95) or which is encoded by the manufacturer (Claim 99), with a system control unit which includes a programming apparatus and operating apparatus as set out in Claim 95. The entire thrust of Pinnow is that the user encode the transmitter. (This is so even of the "inexpensive unit having a minimum of features" described at column 6, lines 22-25.)

The Examiner bears the burden of establishing a prima facie case of obviousness based on the prior art. "... 'This burden can be satisfied only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references.' The patent applicant may then attack the Examiner's prima facie determination as improperly made out, or the applicant may present objective evidence tending to support a conclusion of nonobviousness." In re Fritch, 23 USPQ 1780, 1783 (Fed.Cir. 1992).

It is applicant's position that the Office has failed to meet its burden of establishing a prima facie case of obviousness. The art of record does not teach or suggest applicant's invention. Further, the cited references, alone or in combination, do not teach or suggest an electronically programmable vehicle security system as in applicant's invention wherein the transmitter code is non-user programmable.

The dependent claims stand allowable as patentably distinct from the invention of Claim 95. For example, Aydin teaches away from the use of a program switch accessible to the user to put the system in a programming mode. Instead Aydin to reprogram the code requires the existing

code be entered. None of the cited references teach or suggest the invention of Claim 99, wherein the remote control transmitter is encoded with the transmitter code by the manufacturer thereof. It is further noted that, regarding the invention of Claim 98 for example, a plurality of different transmitters with different transmitter codes can be used to arm or disarm the security system. In contrast to this, Aydin describes a hotel system wherein each hotel guest sharing a room must also share the same card code. Consequently, if a card is lost or stolen, all card keys must be changed to a new code, since once a new code is programmed another person who shares the room has no choice but also to have his/her card changed. This could cause great inconvenience if the second person returns separately to the room to find that his/her card no longer opens the door. In contrast to this, if one remote control transmitter is lost, only the user of that remote control needs to obtain a new transmitter. None of the other users are affected.

The Drori declarations filed herewith and on June 1, 1995 have established that the invention has been commercially successful, in that the assignee has sold over a million remote control auto security systems with the electronically programmable remote control feature, and has obsoleted conventional vehicle security systems marketed by the assignee which have not included the invention. This outstanding commercial success is powerful evidence that this invention would not have been obvious to those of ordinary skill in the art when the invention was made. The Office has not refuted this evidence.

For these reasons, applicant respectfully requests that the outstanding rejection under Section 103 be withdrawn.

Double Patenting Rejection.

Claims 95, 96, 98--106 stand rejected under 35 USC § 101 as claiming the same invention as that of Claims 1-10 of U.S. Patent 5,146,215. The rejection is traversed.

In order for double patenting prohibited by Section 101 to exist, the issued patent and the pending application must claim identical subject matter. MPEP § 804.

U.S. Patent 5,146,215 does not claim subject matter which is identical to the claimed subject matter at issue in this application. The only limitation addressed by the Office is that of "arming or disarming" as set out in the claims of the '215 patent. Applicant denies that this limitation is identical to claims 95-106, which include the feature of a control unit operating apparatus which arms the antitheft apparatus upon a first receipt and recognition of receiver signals corresponding to the signature control signal, and for disarming the antitheft apparatus upon a second receipt and recognition of receiver signals corresponding to the signature control signal. Further, claims of the '215 patent include the limitation that the transmitter code be fixed, while the claims of this application do not include this limitation.

Further, claims of the '215 patent include other limitations not found in the pending application claims. These include, by way of example only, the cooperation of the transmitter and receiving means to form a one-way radio frequency signal transmission link for communicating signals only from the transmitter to the receiver (Claim 1 and other claims); automatic termination of the program mode after a predetermined time delay from receipt of the last transmitted encoded signal during the program mode (Claims 1 and 5); the control unit is operable in the program mode to record a plurality of different transmitter encoded signals of different code bit lengths as valid

signature control words, and operable in the operating-receive mode to decode and compare the decoded signals of different bit lengths to each of the recorded signature code signals (Claim 8); and a multi-channel remote control transmitter as in Claim 10. The Office has not addressed these limitations.

Since the '215 patent and the pending claims are not directed at identical subject matter, there is no prohibited double patenting involved. This rejection should be withdrawn.

New Claims 107-110.

New Claim 107 is drawn to similar subject matter as that of Claim 95, but more generally describes the function carried out by the control unit in the operating mode upon receipt and recognition of the signature control word. New Claim 109 is an independent claim which also defines over the art.

In view of the foregoing amendments, applicant submits that the application is in condition for allowance. Such favorable action is solicited.

Respectfully submitted,



Larry K. Roberts
Registration No. 28,464

Dated: October 17, 1995

Roberts and Quiogue
P.O. Box 8569
Newport Beach, CA 92658-8569
Telephone (714) 640-6200
Facsimile (714) 640-1206